

ESTTA Tracking number: **ESTTA213770**

Filing date: **05/27/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Fox News Network, LLC
Granted to Date of previous extension	05/28/2008
Address	1211 Avenue of the Americas New York, NY 10036 UNITED STATES
Attorney information	Timothy J. Lyden Hogan & Hartson L.L.P. 8300 Greensboro Drive, Suite 1100 Box Intellectual Property McLean, VA 22102 UNITED STATES boxip@hhlaw.com Phone:7036106100

Applicant Information

Application No	77101706	Publication date	01/29/2008
Opposition Filing Date	05/27/2008	Opposition Period Ends	05/28/2008
Applicant	Chicago Tribune Company 435 North Michigan Avenue Chicago, IL 60611 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2002/10/30 First Use In Commerce: 2002/10/30
All goods and services in the class are opposed, namely: Providing information on news in the nature of current events reporting, on leisure in the nature of cultural events, music, theater, sports and restaurants; on fine and performing arts; and on entertainment concerning the motion picture industry, the television industry and sports, by means of a global computer network; production of cable television segments featuring news, leisure, arts and entertainment

Grounds for Opposition

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Attachments	DOC191.PDF (7 pages)(222926 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address

record by First Class Mail on this date.

Signature	/Timothy J. Lyden/
Name	Timothy J. Lyden
Date	05/27/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of

Mark: REDEYE I (& Design)
Application No.: 77,101,706
Published: January 29, 2008

FOX NEWS NETWORK, LLC,

Opposer,

v.

CHICAGO TRIBUNE COMPANY,

Applicant.

Opposition No. _____

Box TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

NOTICE OF OPPOSITION

Opposer, Fox News Network, LLC, a Delaware limited liability company located and doing business at 1211 Avenue of the Americas, New York, NY 10036 (“FNC” or “Opposer”), hereby files this Notice of Opposition to registration of the mark “REDEYE I (& Design)” (the “Subject Mark”) (U.S. Trademark Application No. 77,101,706) (the “Application”), filed by the Chicago Tribune Company, a Delaware corporation located and doing business at 435 N. Michigan Avenue, Floor 6, Chicago, IL 60611 (“Tribune” or “Applicant”), and published in the Official Gazette of the United States Patent and Trademark Office (“PTO”) on January 29, 2008, timely requests having been made to extend the time to oppose.

FNC asserts that the Subject Mark is not being used as stated in the application, that registration of the Subject Mark should be refused as fraudulent, and that FNC will be damaged by registration of the Subject Mark on the following grounds:

Introduction

1. FNC is the owner and operator of the Fox News Channel, the number-one rated 24/7 national cable and satellite television news network in the United States.
2. On information and belief, the Tribune owns and operates a free, regional, tabloid-style newspaper called REDEYE that is distributed in the Chicagoland area only. The Tribune owns federal trademark registrations for REDEYE and REDEYE I (& Design) for “newspapers for general circulation” (Reg. Nos. 2,921,483 and 2,918,012, respectively), which were issued by the PTO on January 25, 2005 and January 11, 2005, respectively (the “Tribune’s Registrations”).
3. On February 6, 2007, FNC launched a late-night television program, “Red Eye w/ Greg Gutfeld” (“FNC’s Red Eye” or “Red Eye”). FNC’s Red Eye presents an irreverent, offbeat, humorous spin on the news. It is intended to be the television equivalent of a blog, and is hosted by Greg Gutfeld, a former editor of *Maxim UK* who had achieved renown in the blogosphere as the author of the blog “The Daily Gut” (<http://www.dailygut.com>) and as the conservative contributor to the liberal blog, “The Huffington Post” (<http://www.huffingtonpost.com>).
4. On February 7, 2007 – the day after FNC’s Red Eye debuted – Tribune filed its application for the Subject Mark with the PTO. In its initial application, the Tribune alleged that it first used the Subject Mark in connection with “[p]roviding news, leisure, arts and entertainment information, by means of a global computer network” since October 30, 2002 (the

same date the Tribune claimed as its first use for its REDEYE newspaper), and in connection with “[p]roviding news, leisure, arts and entertainment information, by means of cable television” since January 13, 2006.

5. On February 14, 2007 – just seven days after filing its application for the Subject Mark – Tribune filed a complaint and motion for a preliminary injunction against FNC in the United States District Court for the Northern District of Illinois, alleging trademark infringement and unfair competition under federal law, and state law dilution based on FNC’s Red Eye (the “District Court Action”).

6. On April 4, 2007, after a three-day evidentiary hearing, the Tribune’s motion for a preliminary injunction was denied. Judge Elaine E. Bucklo of the United States District Court for the Northern District of Illinois held that the Tribune had not shown a likelihood of confusion between the FNC’s use of Red Eye w/ Greg Gutfeld in connection with its television (and related) services, and the Tribune’s use of REDEYE.

7. On May 8, 2007, the PTO sent the Tribune an Office Action with respect to its Application, which stated, “The identification of services is unacceptable because the wording ‘news, leisure, arts, and entertainment information’ and ‘by means of cable television’ is indefinite. The applicant must indicate the specific types of news, leisure, art, and entertainment. The applicant must also indicate the nature of the cable services, e.g., production of cable television programs.” The PTO proposed possible language that it said the applicant could adopt, if accurate.

8. On June 7, 2007, FNC filed applications with the PTO to register its marks, RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design) (“FNC’s Applications”), in connection with “entertainment services in the nature of an on-going

television news program”. The PTO assigned FNC’s Applications Serial Nos. 77/200,629 and 77/200,700, respectively.

9. On June 15, 2007, FNC and the Tribune entered into a stipulation of dismissal of the District Court Action pursuant to a confidential settlement agreement, and the District Court dismissed the action with prejudice on June 18, 2007.

10. In response to FNC’s Applications, the PTO issued an Office Action for each on September 14, 2007, citing an initial refusal to register based on a likelihood of confusion with the Tribune’s Registrations for REDEYE and REDEYE I (& Design) for newspapers. The PTO also cited to the Application, as well as to the Tribune’s co-pending application for REDEYE, as potentially conflicting prior applications.

11. On November 8, 2007, the Tribune filed its Responses to Office Action, in which it proposed to amend its description of its services to “[p]roviding information on news in the nature of current events reporting, on leisure in the nature [sic] of cultural events, music, theater, sports and restaurants; on fine and performing arts; and on entertainment concerning the motion picture industry, the television industry and sports, by means of a global computer network; production of cable television segments featuring news, leisure, arts and entertainment”. This amendment was apparently based on the proposed language suggested by the PTO.

Furthermore, in its amendment, the Tribune listed the first date of use as October 30, 2002.

12. On March 4, 2008, FNC filed its Responses to Office Action for the applications for RED EYE W/ GREG GUTFELD and RED EYE W/ GREG GUTFELD (& Design).

13. On April 8, 2008, the PTO filed a Notice of Suspension with respect to FNC’s Applications. In addition to refusing to register FNC’s marks based on a perceived likelihood of confusion with the Tribune’s marks for the REDEYE and REDEYE I (& Design) in connection

with newspapers, the PTO stated, “Action on this application is suspended pending the disposition of: Application Serial No(s). 77101529 and 77101706.” Thus, FNC’s application has been suspended pending disposition of the Tribune’s Applications.

14. FNC’s television program remains on the air to this day.

The Tribune’s REDEYE I (& Design) Mark Has Not Been Used In Commerce For All Of The Uses Stated In The Application

15. On information and belief, the Tribune knew or should have known that it has not used the Subject Mark for each and every use cited in its Application within the meaning of “use in commerce” in the Trademark Act, 15 U.S.C. §§ 1051 and 1127.

16. On information and belief, the Tribune knew or should have known that it has not used the Subject Mark in connection with cable television services ever, and certainly not as of February 7, 2007 (when the Tribune filed its application for the Subject Mark), much less as of October 30, 2002 (when the Tribune states it first used the Subject Mark).

17. On information and belief, rather than using the Subject Mark in connection with cable television services, the Tribune merely promotes its newspaper, on a local television station that it owns. This promotion is incidental use to the distribution of the newspaper, and not a separate use. On information and belief, the Tribune does not use the mark for the “production of cable television segments featuring news, leisure, arts and entertainment” as it claims in its Application.

18. On information and belief, the Tribune knew or should have known that it is not currently using its mark for television services in any way.

19. On information and belief, the Tribune knew or should have known that it did not first use the Subject Mark in connection with a global computer network as of October 30, 2002.

20. Based on the timing of the Tribune's application (which was filed the very day after FNC's Red Eye W/ Greg Gutfeld program debuted, and one week before the Tribune commenced its lawsuit against FNC), as well as the weakness of the application and its inclusion of facts that the Tribune knew or should have known were untrue, intent on the part of the Tribune to defraud the PTO may be inferred.

21. As the Tribune has not rendered the services in commerce since the date alleged in the declaration, the entire application should be refused as fraudulent.

Harm Resulting From Use And Registration Of REDEYE I (& Design)

22. FNC actually uses its mark in connection with cable television services and should not be prevented from registering its mark based on the Tribune's fraudulent Application.

23. FNC cannot obtain a registration for its own lawful use of its mark while the Tribune's Application is pending. On information and belief, if the registration for the Tribune's fraudulent Application issues, FNC's mark will be denied registration by the PTO.

24. In view of the above allegations, the Tribune is not entitled to registration of its mark because it does not use the mark as stated on its Application.

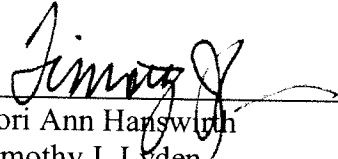
WHEREFORE, Opposer FNC prays that this opposition be sustained and that no registration be issued on Application Serial Number 77,101,706 to Applicant Tribune. The undersigned, on behalf of Opposer Fox News Network, LLC, hereby files this Notice of Opposition in triplicate and authorizes the PTO to charge the required filing fee of \$300.00 to deposit account of Hogan & Hartson L.L.P., Deposit Account No. 08-2550.

Respectfully submitted,

HOGAN & HARTSON L.L.P.

Date: May 27, 2008

By:


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Fox News Network, LLC

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